Serial No. 10/070,677
Amendment dated: November 13, 2006
Response to Office Action dated: August 17, 2006

REMARKS

This Reply is being filed in response to the Office Action dated August 17, 2006. This Reply is timely filed. At the time of the Office Action, claims 1-25 were pending in the application. Claims 1-25 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite. Claims 1, 2 and 4-25 have been rejected under 35 USC §103(a) as being unpatentable over DiGiorgio (U.S. 6,877,094). Claim 3 is objected to as being dependent upon a rejected base claim. The rejections are set out in more detail below.

I.   Brief Review of Applicants' Invention

Prior to addressing the Examiner's rejections on the art, a brief review of Applicant's invention is appropriate. The invention concerns a process and system for managing and leasing memory capacity on a plurality of smartcards and/or smartcard terminals. The capacity is leased to developers of various applications who wish to load their applications on desired smartcards or smartcard terminals. The system and process includes a plurality of host systems each adapted to interact with some or all of the smartcards and terminals. The smartcards and terminals include a multiple application operating system.

In addition, the system and process includes card software located on the smartcards, terminal software located on the terminals, control software located on one or more remotely located processing devices, and a database in communication with the remotely located processing devices, the database including details of which applications are permitted to be loaded onto which smartcards or terminals. The smartcard software, terminal software and the control software cooperate so as to utilize the operating system on each smartcard or terminal to download or delete applications on each smartcard or terminal, such that said system provides a software system which enables the remote loading and deletion of applications independent of the operating system on each smartcard or terminal.

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II. Claim Rejections based on §112

The Examiner rejected claims 1-25 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner asserts that the claims contain numerous terms which render the claimed material indefinite. Specifically, the Examiner asserts that the terms "and/or," "may wish to load" and "confirming desire" impose no limitation upon the claimed invention. Applicant has amended the claims by clarifying these terms and more distinctly claiming the invention.

Further, the Examiner asserts that claims 10-25 are rejected under 35 U.S.C. §112, second paragraph, as being omnibus claims. Applicant has canceled claims 10-25. In addition, applicant has made some other minor amendments to the claims to correct some other informalities not cited by the Examiner.

Applicant believes that claims 1-9 as amended are in a condition for allowance and the rejection of the claims under 35 U.S.C. §112, second paragraph, must be withdrawn.

III. Claim Rejections on Art based on §103(a)

The Examiner rejected claims 1, 4, 6 and 8 under 35 U.S.C. §103(a) as being unpatentable over DiGiorgio (U.S. 6,877,094) (hereinafter "DiGiorgio").

With respect to independent claim 4, the Examiner asserts that DiGiorgio discloses a process for arranging the lease of capacity of on one or more smartcards for utilization by an application provider for use in an environment including a plurality of smartcards and terminals, a host system adapted to interact with some or all of the smartcards and terminals, the smartcards and terminals including a multiple application operating system, and a system including at least card software located on said cards, terminal software located on said terminal, control software located on one or more remotely located processing devices, and a database in communication with at least said remotely located processing devices, said database including details of which

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applications are permitted to be loaded onto which cards and/or terminals, said process
including the step of the application provider requesting a search, using a set of user
defined criteria, of said database in order to locate terminals and/or smartcards on
which the provider may wish to load an application, the control software conducting a
search and returning a report to the application provider, the application provider
confirming his desire to the control software to rent space, the control software
requesting approval from the one or more card and/or terminal owners of the
application provider to rent space, the card and/or terminal owner sending an approval
to the control software, and the control software sending a confirmation that the lease
has been approved to the application provider.

The Examiner asserts that DiGiorgio discloses the claimed invention except for
the "plurality of host systems." The Examiner reasons that it would have been obvious
to one having ordinary skill in the art at the time the invention was made to use a
plurality of host systems, since it has been held that mere duplication of the essential
working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v.
Bemis Co.,* 193 USPQ 8.

In addition, the Examiner asserts that independent claims 1, 6 and 8 are parallel
to claim 4 and are rejected for the same reason. The Examiner did not address the
grounds for rejection of dependent claims 2, 4-5, 7 and 9 but Applicant assumes that
these claims were rejected since they depend upon rejected base claims.

With all due respect to the Examiner, Applicant submits that DiGiorgio is not
available as prior art since any rejection based upon 35 U.S.C. §103(a) must also be
premised upon a reference that could properly be used as a ground for rejection under
35 U.S.C. §102. Applicant submits that no such ground for a rejection exists under 35
U.S.C. §102 for the DiGiorgio patent. If there is such a ground for rejection, Applicant
respectfully requests that the Examiner point out for Applicant the applicable subsection
of 35 U.S.C. §102 that the Examiner is relying upon.

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Further, Applicant submits that the priority date of the Australian priority document for this application is September 7, 1999. The filing date of the DiGiorgio patent is July 28, 2000. The Australian priority document has a filing date that is earlier than the filing date of the DiGiorgio patent. Applicant submits it is entitled to the priority date of the Australian priority document and the rejection of independent claims 1, 4, 6 and 8 under 35 U.S.C. §103(a) as being unpatentable over DiGiorgio is improper and must be withdrawn. The rejection of claims 2-5, 7 and 9 is improper by virtue of their dependence upon allowable base claims and such rejection must also be withdrawn. Accordingly, Applicant believes claims 1-9 are now in a condition for allowance.

IV. Conclusion

The rejection of claims 1-9 under 35 USC §112, second paragraph, must be withdrawn since Applicant has amended the claims to conform to the Examiner's requirements. Claims 10-25 are cancelled. The rejection of claims 1-9 under 35 U.S.C. §103(a) was improper since the cited reference is not available as prior art. Accordingly, Applicant believes all claims are in a condition for allowance and requests that a Notice of Allowance be issued.

The Commissioner is hereby authorized to charge any fees which may be due by submission of this document to Deposit Account No. 50-2884.

Respectfully submitted,

Date: 11-13-06
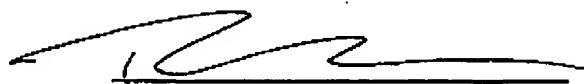
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